

DECLARATION
Utility Application

COPY

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled METHOD FOR PRODUCING IMMUNOGLOBULINS CONTAINING PROTECTION PROTEINS AND THEIR USES the specification of which

(Check One)

☐
☒

is attached hereto OR
was filed on May 4, 1995 as United States Application Serial No. 08/434,000 or PCT International Application No. _____ and was amended on _____ (if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above.

I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations, § 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or of any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Date of Filing	Priority Claimed	
			Yes	No

I hereby claim the benefit under Title 35, United States Code §119(e) of any United States provisional application(s) listed below.

Application Number(s)	Filing Date

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s), or § 365(c) of any PCT international application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT international application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

U.S. Parent Application Number	PCT Parent Number	Parent Filing Date	Status-Patented, Pending or Abandoned
08/367,395		December 30, 1994	Abandoned

Send Correspondence to: Jeffrey W. Guise	LYON & LYON LLP 633 W Fifth St., Suite 4700 Los Angeles, CA 90071	Direct Telephone calls to: (619) 552-8400
--	---	--

	FULL NAME OF INVENTOR	FIRST Name Andrew	MIDDLE Initial C.	LAST Name Hiatt	
201	RESIDENCE & CITIZENSHIP	City San Diego	State or Foreign Country CA	Country of Citizenship USA	
	POST OFFICE ADDRESS	660 Torrance Street	City San Diego	State or Country CA	Zip Code 92103
	FULL NAME OF INVENTOR	FIRST Name Julian	MIDDLE Initial K.-C.	LAST Name Ma	
202	RESIDENCE & CITIZENSHIP	City London	State or Foreign Country England	Country of Citizenship England	
	POST OFFICE ADDRESS	81 Grierson Road	City London	State or Country England	Zip Code SE231P E
	FULL NAME OF INVENTOR	FIRST Name Thomas	MIDDLE Initial	LAST Name Lehner	
203	RESIDENCE & CITIZENSHIP	City Herts	State or Foreign Country England	Country of Citizenship England	
	POST OFFICE ADDRESS	2 Wood Ride Hadley Wood, Barnet	City Herts	State or Country England	Zip Code EN40LL
	FULL NAME OF INVENTOR	FIRST Name Keith	MIDDLE Initial E.	LAST Name Mostov	
204	RESIDENCE & CITIZENSHIP	City San Francisco	State or Foreign Country CA	Country of Citizenship USA	
	POST OFFICE ADDRESS	1975 Funston Avenue	City San Francisco	State or Country CA	Zip Code 94116
	FULL NAME OF INVENTOR	FIRST Name	MIDDLE Initial	LAST Name	
205	RESIDENCE & CITIZENSHIP	City	State or Foreign Country	Country of Citizenship	
	POST OFFICE ADDRESS		City	State or Country	Zip Code
	FULL NAME OF INVENTOR	FIRST Name	MIDDLE Initial	LAST Name	
206	RESIDENCE & CITIZENSHIP	City	State or Foreign Country	Country of Citizenship	
	POST OFFICE ADDRESS		City	State or Country	Zip Code

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Title 18, United States Code, § 1001 and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signature of Inventor	201
Date	
Signature of Inventor	202
Date	
Signature of Inventor	203
Date	

Signature of Inventor	204
Date	5/1/99
Signature of Inventor	205
Date	
Signature of Inventor	206
Date	

(Signatures should conform to names as presented at 201 et seq. above.)

DECLARATION
Utility Application

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled METHOD FOR PRODUCING IMMUNOGLOBULINS CONTAINING PROTECTION PROTEINS AND THEIR USES the specification of which

(Check One) ☐ is attached hereto OR
☒ was filed on May 4, 1995 as United States Application Serial No. 08/434,000 or PCT International Application No. _____ and was amended on _____ (if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above.

I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations, § 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or of any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Date of Filing	Priority Claimed	
			Yes	No

I hereby claim the benefit under Title 35, United States Code §119(e) of any United States provisional application(s) listed below.

Application Number(s)	Filing Date

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s), or § 365(c) of any PCT international application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT international application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

U.S. Parent Application Number	PCT Parent Number	Parent Filing Date	Status-Patented, Pending or Abandoned
08/367,395		December 30, 1994	Abandoned

Send Correspondence to: Jeffrey W. Guise	LYON & LYON LLP 633 W Fifth St., Suite 4700 Los Angeles, CA 90071	Direct Telephone calls to: (619) 552-8400
--	---	--

	FULL NAME OF INVENTOR	FIRST Name Andrew	MIDDLE Initial C.	LAST Name Hiatt	
201	RESIDENCE & CITIZENSHIP	City San Diego	State or Foreign Country CA	Country of Citizenship USA	
	POST OFFICE ADDRESS	660 Torrance Street	City San Diego	State or Country CA	Zip Code 92103
	FULL NAME OF INVENTOR	FIRST Name Julian	MIDDLE Initial K.-C.	LAST Name Ma	
202	RESIDENCE & CITIZENSHIP	City London	State or Foreign Country England	Country of Citizenship England	
	POST OFFICE ADDRESS	81 Grierson Road	City London	State or Country England	Zip Code SE231P E
	FULL NAME OF INVENTOR	FIRST Name Thomas	MIDDLE Initial	LAST Name Lehner	
203	RESIDENCE & CITIZENSHIP	City Herts	State or Foreign Country England	Country of Citizenship England	
	POST OFFICE ADDRESS	2 Wood Ride Hadley Wood, Barnet	City Herts	State or Country England	Zip Code EN40LL
	FULL NAME OF INVENTOR	FIRST Name Keith	MIDDLE Initial E.	LAST Name Mostov	
204	RESIDENCE & CITIZENSHIP	City San Francisco	State or Foreign Country CA	Country of Citizenship USA	
	POST OFFICE ADDRESS	1975 Funston Avenue	City San Francisco	State or Country CA	Zip Code 94116
	FULL NAME OF INVENTOR	FIRST Name	MIDDLE Initial	LAST Name	
205	RESIDENCE & CITIZENSHIP	City	State or Foreign Country	Country of Citizenship	
	POST OFFICE ADDRESS		City	State or Country	Zip Code
	FULL NAME OF INVENTOR	FIRST Name	MIDDLE Initial	LAST Name	
206	RESIDENCE & CITIZENSHIP	City	State or Foreign Country	Country of Citizenship	
	POST OFFICE ADDRESS		City	State or Country	Zip Code

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Title 18, United States Code, § 1001 and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signature of Inventor	201
Date	
Signature of Inventor	202
Date	1.5.99
Signature of Inventor	203
Date	30.4.99

Signature of Inventor	204
Date	
Signature of Inventor	205
Date	
Signature of Inventor	206
Date	

(Signatures should conform to names as presented at 201 et seq. above.)



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 27

COPY

Jeffrey W. Guise
Lyon & Lyon
First Interstate World Center
633 West Fifth Street, Suite 4700
Los Angeles, CA 90071-2066

COPY MAILED

DEC 01 1999

SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

In re Application of
Andrew C. Hiatt, et al
Application No. 08/434,000
Filed: May 4, 1995
Attorney Docket No. 212/127

:
:
: DECISION ON PETITIONS UNDER
: 37 CFR 1.48(a) AND 1.183
:

This is a decision on May 18, 1999 petitions under 37 CFR 1.48(a), requesting correction of the inventorship and under 37 CFR 1.183, requesting waiver of a requirement under 37 CFR 1.48(a)(2), and on the paper of October 15, 1999 filed in support thereof, which timely responds to a September 13, 1999 Requirement for Information.

The §1.48(a) petition to correct inventorship is Granted.

The petition under 37 CFR 1.183 is Granted.

Background

The Requirement for Information:

- noted the request to add Mostov as an inventor, and
- required:
 - compliance with § 3.73(b) for written consents of assignees submitted by King's College London (the consent did not refer to an attached assignment document), and Planet Biotechnology (no assignment document was submitted), and
 - original named inventor Hiatt to execute a § 1.63 declaration in compliance with § 1.63(e) with the new inventive entity to notify Hiatt of a duty of disclosure under § 1.56 for CIP applications (which was omitted from his original § 1.63

RECEIVED
DEC 06 1999
U.S. PROSECUTION

declaration), and to provide notice to him of the intent to add an inventor.

The response of October 15, 1999 has submitted:

- a new written consent of King's College London that refers to attached Assignment documents,
- a Declaration on behalf of Planet Biotechnology stating:
 - there is no U.S. assignment to Planet Biotechnology by Hiatt (para. 3), and
 - that Hiatt was asked to sign a Declaration in compliance with §§ 1.56 and 1.63 and refused to do so (paras. 4 and 6).

Decision on Petition Under 37 CFR 1.48(a)

In view of the submission of the written consent of King's College of London in compliance with § 3.73(b), Planet Biotechnology not apparently being an actual assignee, and the grant of the Petition under 37 CFR 1.183, *infra*, no outstanding issue exists.

The § 1.48(a) petition is Granted.

Decision on Petition Under 37 CFR 1.183

In view of the refusal of Hiatt to execute a new § 1.63 declaration appropriate for the instant CIP application with the correct inventive entity set forth, waiver of § 1.48(a)(2) and reexecution of a § 1.63 declaration by Hiatt is appropriate.

The petition under 37 CFR 1.183 is Granted.

The application is being returned to the Initial Patent Examination Division of the Office of Initial Patent Examination for further processing, including issuance of a corrected filing receipt, with the names of the four inventors as shown on the two executed declarations under 37 CFR 1.63 filed on May 18, 1999.



Hiram H. Bernstein
Senior Legal Advisor
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects
(703) 305-9285